

REMARKS:

The Office Action dated January 28, 2004, has been carefully considered. In response thereto, the above amendments and following remarks have been prepared. Applicant respectfully submits that the application is in condition for allowance. Accordingly, reconsideration and withdrawal of the rejections in the Office Action and issuance of a Notice of Allowance are respectfully requested.

Allowed Subject Matter and New Claims

Claim 29 is indicated as being allowed if re-written in independent form including all of the limitations of claim 1 from which it depends.

Claims 32 and 34 are indicated as being allowable if re-written to overcome the rejections under 35 U.S.C. § 112, second paragraph, and to include all of the limitations of any base claim (i.e., claim 32 is the base claims for dependent claim 34) (note: in the Office Action, the Examiner cites § 112, first paragraph, to reject claims 32-34).

Claims 33 and 35 are indicated as being allowable if re-written or amended to overcome the rejection under 35 U.S.C. § 112, second paragraph (note: in the Office Action, the Examiner cites § 112, first paragraph, to reject claims 32-35).

Applicant has amended claim 29 to include all of the limitations of claim 1. Applicant submits that claim 32-35 have been amended in such a way as to overcome the § 112, second paragraph, rejection. Allowance of those claims is respectfully requested.

New claims 36-48, which depend from claim 34, are being added to cover the disclosed invention. Those dependent claims are substantially the same as dependent claims 2-19 and 30, where appropriate. No new matter is being added. No additional prior art search should be required.

Objection of Figure 1

Figure 1 has been objected to because the ball 7 in the second position shown by broken lines should also be shown as a broken line. Figure 1 was also objected to because the slack feature is not identified on the drawing. Applicant submits herewith a formal drawing with Figure 1 having the appropriate corrections. Specifically, reference number 2' was added to identify the slackness in the lower guideway 2 and reference number 9' was

added to identify the slackness in the lower line 9. Withdrawal of the objection of Figure 1 is respectfully requested.

Objection of the Specification

The specification has been objected to because it does not provide a proper antecedent basis for the lower guideway being slack when the ball is at rest. Applicant has amended the specification to address this objection by specifically referring to the lowers guideway 2 and line 9 being slack in the starting position. Withdrawal of the objection of the specification is respectfully requested.

Rejection of Claim 8 Under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 8 under 35 U.S.C. § 112, first paragraph. Claim 8 recites “wherein the lower guideway is adjustably engaged to the stable support” (the recited stable supports are synonymous with the upright supports 3, 4 described in the specification). The rejection of claim 8 is based on the assertion that “the disclosure provides support for the lower guideway to be attached to the stable support, however, the specification does not provide support for the lower guideway to be adjustably engaged” (citing pages 3 and 4 of the application). The rejection is also based on the assertion that “[a]s best seen from the drawings the lower guideway should be adjustably connected to the stable supports, but [the] specification indicates that the lower guideway are [sic; *is*] adjustably engaged with the ground.”

The test for compliance with 35 U.S.C. § 112, first paragraph, is whether sufficient information is provided in the original disclosure to show that the inventor possessed the invention at the time of the original filing. Moba B.V. v. Diamond Automation Inc., 66 U.S.P.Q.2d 1429, 1439 (Fed. Cir. 2003); see also Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1115 (Fed. Cir. 1991). As previously stated, “the possession test requires assessment from the viewpoint of one of skill in the art.” Id. (citing Union Oil Co. of Cal. v. Atlantic Richfield Co., 54 U.S.P.Q.2d 1227, 1232 (Fed. Cir. 2000) (“The written description requirement does not require the applicant ‘to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed’”) (citation omitted)). Where the record shows that

the specification teaches one of skill in the art how to make and use an invention, it also should convince that artisan that the inventor possessed the invention. Id. An applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention. A specification may, within the meaning of 35 U.S.C. §112, first paragraph, contain a written description of a broadly claimed invention without describing all species that the claim encompasses. Cordis Corp. v. Medtronic AVE Inc., 67 U.S.P.Q.2d 1876, 1886 (Fed. Cir 2003) (citing cases).

In this case, Figure 1 shows the lower guideway attached to the upright supports 3, 4 at the point where the upright supports engage the ground. Figure 4, in comparison, shows the lower guideway attached to the upright supports at a point above the ground. Claim 8 recites that the lower guideway is adjustably engaged to the stable support. Thus, as the Examiner correctly acknowledges in the Office Action, “the lower guideway should be adjustably connected to the stable supports.” (emphasis added). On page 3 of the application it states that by “moving one end of the lower guideway nearer to a point directly below an end of the upper guideway increases the speed and force of the ball approaching a player standing at a fixed point.” Although that statement “does not describe exactly the subject matter claimed” in claim 8, the statement also does not disclaim or limit how and to what the lower guideway is engaged to. What it does disclose, however, in combination with the drawings, is that the end of the lower guideway is engaged/connected to the stable support and the end is moveable up and down on the stable support relative to the upper guideway. That is, the drawings and specification, taken as a whole, indicate that the lower guideway is adjustably engaged to the stable supports.

It is true that on page 3 of the application it also states that “[i]t is preferred that the ends of the lower guideway are adjustably engaged with the ground.” However, as noted above, satisfying the written description requirement of 35 U.S.C. §112, first paragraph, does not mean that the specification must describe all species or embodiments that the claim encompasses, or exactly how the lower guideway is adjustably engaged with the ground. In this case, although the specification only describes one embodiment in which the term “adjustably engaged” is used, that does not mean a claim encompassing what is “described” in the drawings should be ignored. Here, the written description clearly allows persons of

ordinary skill in the art to recognize that the applicant invented what is claimed in compliance with 35 U.S.C. § 112, first paragraph.

Rejection of Claims 32-34 Under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 32-34 under 35 U.S.C. § 112, first paragraph because the specification defines a stable support as a pole or wall but the claims only recite “at least one” upstanding stable support. Independent claims 32 and 34 have been amended to recite that a pole is connected to the first end of the upper and lower guideways, and a pole or a wall is connected to the second end of the upper and lower guideways. Applicant submits that amended claims 32 and 34 overcome the Examiner’s rejection of those claims.

Rejection of Claims 1-5, 7-9, 11-15, 18, 19, 30 and 34 Under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-5, 7-9, 11-15, 18, 19, 30 and 34 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,630,521 to *Lingbeek* in view of U.S. Patent No. 5,460,364 to *Ring*. Claim 1 has been cancelled; therefore, the rejection of claim 1 is moot. Applicant respectfully traverses the rejection of the remaining claims for the following reasons.

Amended claim 29 incorporates the limitations of cancelled claim 1. If amended in that manner, the Examiner has indicated that the claim would be allowable over the cited art. Since claims 2-5, 7-9, 11-15, 18, 19 and 30 depend from claim 29, the subject matter of those claims should also be allowable. Accordingly, allowance of claim 29 and withdrawal of the rejection of claims 2-5, 7-9, 11-15, 18, 19 and 30 is respectfully requested.

The Examiner has indicated that the amended claim 34 would be allowable over the cited art if re-written, as noted above, to overcome the rejections under 35 U.S.C. § 112, second paragraph. Applicant respectfully submits that it has amended claim 34, as previously described, in such a manner as to satisfy § 112, second paragraph. Accordingly, withdrawal of the rejection of claim 34 is respectfully requested.

Rejection of Claims 10, 16, 17, and 20-26 Under 35 U.S.C. §103(a)

The Examiner has rejected claims 10, 16, 17 and 20-26 under 35 U.S.C. §103(a) as being unpatentable over the prior art as applied to claims 1 and 9, and further in view of U.S.

Patent No. 4,138,107 to *Janis*. Claims 20-26 have been cancelled; therefore, the rejection of those claims is moot. Applicant respectfully traverses the rejection of claims 10, 16 and 17 for the following reasons.

Amended claim 29 incorporates the limitations of cancelled claim 1. If amended in that manner, the Examiner has indicated that the claim would be allowable over the cited art. Since claims 10, 16, and 17 depend from claim 29, the subject matter of those claims should also be allowable. Accordingly, withdrawal of the rejection of claims 10, 16 and 17 is respectfully requested.

Rejection of Claims 28 and 31 Under 35 U.S.C. §103(a)

The Examiner has rejected claims 28 and 31 under 35 U.S.C. §103(a) as being unpatentable over the prior art as applied to claims 1 and 20, and further in view of U.S. Patent No. 3,086,775 to *Albert*. Claim 31 has been cancelled; therefore, the rejection of that claim is moot. Applicant respectfully traverses the rejection of claim 28 for the following reasons.

Claims 28 depends from allowable claim 29; therefore, the subject matter of claim 28 should also be allowable. Accordingly, withdrawal of the rejection of claim 28 is respectfully requested.

Accordingly, for the foregoing reasons, Applicant respectfully requests that the Examiner's objections and rejections of the drawings, specification and the pending claims be withdrawn and a Notice of Allowance be issued.